

REMARKS

Favorable reconsideration of this application is respectfully requested in view of the following remarks. Claims 1-3, 5-9, 11 and 12. Claims 4 and 10 have been canceled. By virtue of the amendments above, Claims 1 and 7 have been amended. No new matter has been introduced by way of the amendments above.

Claim Objections

Claims 5 and 6 were objected to because there was a blank space in each of these claims. However, the originally filed claims should not contain such blank spaces and it is not clear why the Examiner's copy contain such blank spaces. In any event, the listing of claims attached herein reproduces Claims 5 and 6 without any blank space.

Claim Rejection Under 35 U.S.C. §102

The test for determining if a reference anticipates a claim, for the purpose of a rejection under 35 U.S.C. §102, is whether the reference discloses all the elements of the claimed combination, or the mechanical equivalents thereof functioning in substantially the same way to produce substantially the same results. As noted by the Court of Appeals for the Federal Circuit in *Lindemann Maschinenfabrick GmbH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984), in evaluating the sufficiency of an anticipation rejection under 35 U.S.C. §102, the Court stated:

Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.

Therefore, if the cited reference does not disclose each and every element of the claimed invention, then the cited reference fails to anticipate the claimed invention and, thus, the claimed invention is distinguishable over the cited reference.

Claims 1 and 2 were rejected under 35 U.S.C. §102(e) as being anticipated by Gast et al. ("Gast").

It is submitted that this rejection has been overcome by the amendment to Claim 1. More particularly, the amended Claim 1 recites "an elevator connected to the cap and occupying an area within a printing zone of the inkjet printhead." This element is not disclosed by Gast. FIG. 1 of Gast discloses a service station that is outside of the printing zone. The printhead-servicing sled 20 and caps 22a, 22b are located in this service station. Therefore, Gast cannot anticipate Claim 1.

Claim Rejection Under 35 U.S.C. §103

The test for determining if a claim is rendered obvious by one or more references for the purpose of a rejection under 35 U.S.C. § 103 is set forth in MPEP § 706.02(j):

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Therefore, if the above-identified criteria are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s).

Claims 4 and 10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gast.

The Office Action recognizes that Gast does not disclose an elevator occupying an area within a printing zone, but asserts that "[a] service station disposed in the print zone, and in the instant application an elevator mounted

with a capping device, is well known in the art, refer to MPEP 2144.03." Applicants respectfully disagree with this assertion and request that the Office Action provide documentary evidence to support this assertion. Contrary to what has been asserted, the service station, which contains the capping assembly, is conventionally disposed to one side of the print zone. This conventional arrangement is shown in FIG. 1 of Gast and also discussed by applicants in the Background section.

In the present case, Gast fails to teach or suggest all of the elements recited in the claims and the Office Action relied on unsupported conclusion of "common knowledge" to make up for the deficiency. Therefore, the rejection under 35 U.S.C. § 103 is improper because the Office Action fails to establish a *prima facie* case of obviousness. Accordingly, withdrawal of the rejection under 35 U.S.C. § 103 is respectfully requested.

The paragraph bridging pages 5 and 6 of the Office is not understood. In this paragraph, the Office Action stated that "[b]ased upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e)." However, the reference at issue, "Gast," has a grant date of Oct. 3, 1995 and has been used by the Office Action as a reference under 102(b) in the 35 U.S.C. § 102 rejection.

Conclusion

In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited.

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Respectfully submitted,



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